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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,535	02/15/2002	Rosana Kapeller-Libermann	10448-142001 / MPI2001-02	1671

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EXAMINER

MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/076,535

Applicant(s)

KAPELLER-LIBERMANN ET AL.

Examiner

William W. Moore

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-4 and 8, drawn to a polynucleotide encoding a polypeptide that comprises the human carboxypeptidase 23565 having the amino acid sequence set forth in SEQ ID NO:2, including the polynucleotide of SEQ ID NO:1, to vectors comprising the polynucleotide, to host cells comprising the polynucleotide, and to a method of use of the polynucleotide in a recombinant method of making of an encoded polypeptide in a host cell, classified, *inter alia*, in class 536, subclass 23.2.

2. Claims 5, 6 and 14, drawn to a polypeptide comprising the human carboxypeptidase 23565, and to a method of use thereof in a method for identifying a compound capable of binding thereto, classified, *inter alia*, in class 435, subclass 226.

3. Claims 7, 9, and 10, drawn to an antibody capable of selectively binding to a polypeptide comprising the human carboxypeptidase 23565, and to a method of use of the antibody in an assay to detect the presence in a sample of said polypeptide, as well as to a kit comprising a compound that selectively binds to the polypeptide, which compound may be an antibody, classified, *inter alia*, in class 530, subclass 387.1.

4. Claims 11-13, drawn to a method for detecting the presence in a sample of a polynucleotide encoding a polypeptide comprising the human carboxypeptidase 23565, with a nucleic acid probe or primer specific therefor, wherein the detected polynucleotide may be a mRNA, and to a kit comprising said nucleic acid probe or primer specific for said polynucleotide encoding a polypeptide comprising the human carboxypeptidase 23565, classified, *inter alia*, in class 435, subclass 6.

5. Claim 15, drawn to a method for modulating the activity of a polypeptide comprising the human carboxypeptidase 23565, or a cell expressing the polypeptide, comprising contacting the polypeptide or cell with an antibody specific for the human carboxypeptidase 23565, classified in class 435, subclass 7.1.

6. Claims 16-20, drawn to *in vitro* and *in vivo* methods for inhibiting an aberrant activity of a cell expressing the human carboxypeptidase 23565, wherein the inhibitory molecule may be an antibody, classified in class 424, subclass 130.1.

The inventions are distinct, each from the other, because of the following reasons:

Inventions of Groups 1 and 2 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

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The invention of Group 1 is unrelated to inventions of Groups 3-6. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, different functions, and different effects.

The invention of Group 2 is unrelated to inventions of Groups 3-6. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, different functions, and different effects.

Inventions of Groups 3 and 4 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, different functions, and different effects.

Inventions of Groups 3 and 5 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). In the instant case the product as claimed can be used in a materially different process, an assay to detect the presence in a sample of said polypeptide.

Inventions of Groups 3 and 6 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). In the instant case the product as claimed can be used in a materially different process, an assay to detect the presence in a sample of said polypeptide.

The invention of Group 4 is unrelated to inventions of Groups 5 and 6. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed

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as capable of use together and have different modes of operation, different functions, and different effects.

Inventions of Groups 5 and 6 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different functions and effects.


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(h).

A telephone call was made to Ms. Laurie Butler-Lawrence on July 1, 2003, to request an oral election to the above restriction requirement, but did not result in an election being made.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 703.308.0583. The examiner can normally be reached from 9:00AM-5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached at 703.308.3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703.308.4242 for regular communications and 703.308.0294 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0196.

  
William W. Moore  
July 1, 2003